



Docket No.: 243452US0X

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

OBLON  
SPIVAK  
McCLELLAND  
MAIER  
&  
NEUSTADT  
P.C.

ATTORNEYS AT LAW

RECEIVED  
MAY 28 2004  
LICENSING & REVIEW

RE: Application Serial No.: 10/673,172  
Applicants: Yoshitaka SASAKI, et al.  
Filing Date: September 30, 2003  
For: THIN FILM MAGNETIC HEAD AND  
MANUFACTURING METHOD THEREOF  
Examiner: I.J. LOBO

SIR:

Attached hereto for filing are the following papers:

**Reply to Denial of Petition for Retroactive License under 35 U.S.C. §184  
Statement under 37 C.F.R. §5.25(a)(3) in Support of Petition for  
Retroactive License under 35 U.S.C. §184**

Our check in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Norman F. Oblom

Richard L. Chinn, Ph.D.

Registration No. 34,305

Customer Number

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Donald K. Drummond, Ph.D.  
Registration No. 52,834

DOCKET NO: 243452US0X



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

YOSHITAKA SASAKI, ET AL.

: EXAMINER: LOBO, I. J.

SERIAL NO: 10/673,172

:

FILED: SEPTEMBER 30, 2003

: ATTN: LICENSING AND REVIEW

FOR: THIN FILM MAGNETIC HEAD  
AND MANUFACTURING METHOD  
THEREOF

:

*MAY 28 2004*  
*LICENSING & REVIEW*

REPLY TO DENIAL OF PETITION FOR RETROACTIVE LICENSE  
UNDER 35 U.S.C. § 184

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In regard to the above-identified application, Petitioners submit the attached Declaration. The Declaration is submitted to fully meet the requirements set forth in 37 C.F.R. § 5.25(a)(3). The Declaration is made by Yoshijiro Abe who is the person who had knowledge of the proscribed filing and made the decision to file abroad.

Petitioners now believe that all information required by 37 C.F.R. § 5.25(a) has now been submitted and Petitioners respectfully request that the Office grant the Petition.

Petitioners' U.S. representatives' address, facsimile number and telephone number are given below.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon



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Registration No. 34,305

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(OSMMN 08/03)

NFO:DKD\la



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DOCKET NO: 243452US0X

## IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
YOSHITAKA SASAKI, ET AL. : EXAMINER: LOBO, I. J.  
SERIAL NO: 10/673,172 :  
FILED: SEPTEMBER 30, 2003 : ATTN: LICENSING AND REVIEW  
FOR: THIN FILM MAGNETIC HEAD :  
AND MANUFACTURING METHOD :  
THEREOF

## STATEMENT UNDER 37 C.F.R. § 5.25(a)(3) IN SUPPORT OF PETITION FOR RETROACTIVE LICENSE UNDER 35 U.S.C. § 184

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

I, Yoshijiro Abe, hereby certify that:

1. The above-identified application was not under a secrecy order at the time it was filed in Japan and it is not currently under a secrecy order.
2. I filed a corresponding application with the Japanese Patent Office on October 3, 2003 and learned that a first U.S. filing was required by U.S. law on February 10, 2004. I immediately sought advice from our U.S. representatives. Since then I have been diligently seeking a retroactive foreign filing license through our U.S. representatives.
3. I filed the application abroad through error and without deceptive intent. At the time I filed the application in Japan I did not know that U.S. law prohibited such filings. I discovered my error while looking through a file wrapper of an unrelated case and found a foreign filing license attached to the official filing receipt of the unrelated application. The

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MAY. 4.2004 4:02PM OBLON, SPIVAK

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NO. 187 P.3

form cited 35 U.S.C. § 184 and after I checked the code I realized I should have obtained a foreign filing license for the above-identified application.

4. I declare under penalty of perjury under the law of the United States of America that the foregoing is believed to be true and correct.



Yoshijiro Abe

May 12, 2004

Date

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UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/673,172	25-Mar-04	YOSHITAKA SASAKI, ET AL.	243452US0X

Title: THIN FILM MAGNETIC HEAD AND MANUFACTURING  
METHOD THEREOF

Art Unit	Paper Number
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Correspondence Address:

NORMAN F. OBLON  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT  
1940 DUKE STREET  
ALEXANDRIA VA 22314

PATENT & TRADEMARK OFFICE  
MAILED

APR 16 2004

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Richard L. Chinn  
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314

In re: Sasaki et al : DECISION ON REQUEST  
Serial No.: 10/682,172 : UNDER 37 CFR 5.25  
Filing date: September 30, 2003  
Docket No: 243452US0X

**Title: THIN FILM MAGNETIC HEAD AND MANUFACTURING METHOD  
THEREOF**

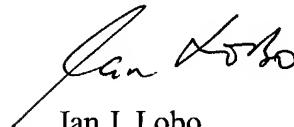
This is a decision on the petition filed on March 25, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied at this time since the requirements set forth in 37 CFR 5.25(a)(3)(iii) have not been fully met. The instant petition is filed by the firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., petitioners US representatives. However, to fully comply with the above requirements, what is needed is a verified statement or statements by the person or persons who had knowledge of the proscribed filing and made the actual decision to file. Such statement(s) should reference the error of not obtaining a foreign filing license. Further, statements of "error and without deceptive intent" must be supported by facts, they should not be merely conclusionary but must include how and why the "error" occurred.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Ian J. Lobo  
Patent Examiner  
(703) 306-4161

25-Mar-04

10/673,172

YOSHITAKA SASAKI ET AL.

**THIN FILM MAGNETIC HEAD AND MANUFACTURING METHOD THEREOF**

Retr: Yes

Expedited: No Docket Number 243452US0X

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10/673,172  
Docket No.: 243452US0X

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

*SD*  
**OBLON**  
**SPIVAK**  
**McCLELLAND**  
**MAIER**  
**&**  
**NEUSTADT**  
P.C.

ATTORNEYS AT LAW

SIR:

Attached hereto for filing are the following papers:

**Petition for Retroactive License under 35 U.S.C. §184**

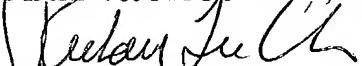
**Certification of Translation**

**English Translation of Application Serial No. 10/673,172**

Our check in the amount of \$130.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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